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10/591,129

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Peter Baur

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EXAMINER

ARNOLD, ERNST V

ART UNIT

PAPER NUMBER

1616

MAIL DATE

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05/12/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,129	<b>Applicant(s)</b> BAUR ET AL.	
	<b>Examiner</b> ERNST V. ARNOLD	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,11-14,16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10,15,17 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 1 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Applicant's election of the species for the active agent and the penetrant in the reply filed on 4/5/10 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1, 2 and 5-25 read on the elected active compound (page 2 of remarks filed on 4/5/10). Claims 1-10, 15, 17, 19 and 20-25 read on the elected penetrant (page 3 of remarks filed on 4/5/10). Therefore, claims 1, 2, 5-10, 15, 17, 19 and 20-25 read on the elected combined subject matter.

Claims 3, 4, 11-14, 16 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/5/10.

Comment: Please insert the continuity data at the top of page 1 of the specification.

### ***Information Disclosure Statement***

Foreign language references have been considered to the extent that an English language abstract or translation or statement of relevance has been provided to the Examiner. References NPL 4, NPL 9 and NPL 10 have not been considered because there is no date associated with the reference on the IDS. 1.98(b) (5) Each publication

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listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, **date**, and place of publication.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: claim 1 contains the word 'closed' in quotation marks. This is not required as the term 'closed penetrant' is defined in [0187-0188]. The Examiner suggests removing the quotation marks which could be interpreted to imply unusual usage of the term. Appropriate correction is required.

Claim 25 is objected to because of the following informalities: after the period there is a 'p'. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-10, 15, 17 and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeer et al. (US 20040157745) and Wolf et al. (WO 03/099005) and Turberg et al. (US 20050214336 filed internationally as WO 2003/086075; published 10/23/03) and Patel et al. (US 5925182).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Applicant claims an oil based suspension concentrate, a method of making the suspension concentrate, a method of applying the suspension concentrate and a method of controlling insects with the suspension concentrate.

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

Vermeer et al. teach alcohol alkoxylates for use in oil based suspension concentrates with at least one active agrochemical, one vegetable oil, one or more non-ionic surfactants and optionally additives (Abstract and claims 1-8). Vermeer et al. teach alcohol alkoxylates as penetration enhancers to improve penetration of agrochemical active compounds into plants in [0068-0073]:

3 [0068] Suitable penetration promoters in the present composition are all those substances which are customarily employed in order to improve the penetration of agrochemical active compounds into plants. Alkanol alkoxylates of the formula



[0069] in which

[0070] R represents straight-chain or branched alkyl having 4 to 20 carbon atoms,

[0071] AO represents an ethylene oxide radical, a propylene oxide radical, a butylene oxide radical, or mixtures of ethylene oxide and propylene oxide radicals or butylene oxide radicals and

[0072] m represents numbers from 2 to 30,

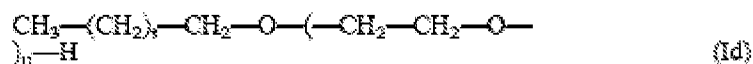
[0073] are preferred.

Vermeer et al. teach in [0093-0098]:

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[0092] s represents numbers from 1 to 10.

[0093] A further particularly preferred group of penetration promoters are alkanol alkoxylates of the formula



[0094] in which

[0095] t represents numbers from 8 to 13 and

[0096] u represents numbers from 6 to 17.

[0097] In the formulae indicated beforehand

[0098] R preferably represents butyl, i-butyl, n-pentyl, i-pentyl, neopentyl, n-hexyl, i-hexyl, n-octyl, i-octyl, 2-ethyl-hexyl, nonyl, i-nonyl, decyl, n-dodecyl, i-dodecyl, lauryl, myristyl, i-tridecyl, trimethylnonyl, palnityl, stearyl or eicosyl.

Thus, alcohol alkoxylates with isobutylene oxide and ethylene oxide are taught by Vermeer et al. *The Examiner's notes that the difference between the alcohol alkoxylates of Vermeer et al. and those instantly claimed is that Vermeer et al. teach compounds terminated by -H on one end, an open penetrant, whereas the instant alcohol alkoxylates are terminated with alkyl groups, a closed penetrant; R-O-(AO)<sub>m</sub>H for Vermeer et al. and R-O-(AO)<sub>m</sub>-R' for the instant claims.*

Vermeer et al. teach that ***insecticides, acaricides***, nematocides etc... can be used in the invention [0020 with examples from 0021-0067]. Use of the suspension concentrate, which the Examiner interprets to mean a method of use, by application to plants or their habitat is taught (claim 10 and [0134-0135]). A process of preparing a suspension concentrate is taught by mixing the ingredients (claim 9 and [0130-0132]). The amount of individual components can be varied within a wide range [0124-0129]:

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[0125] of agrochemical active compounds are in general between 5 and 30% by weight, preferably between 10 and 25% by weight,

[0126] of penetration promoter are in general between 5 and 55% by weight, preferably between 15 and 40% by weight,

[0127] of vegetable oil are in general between 15 and 55% by weight, preferably between 20 and 50% by weight,

[0128] of surfactants or dispersing aids are in general between 2.5 and 30% by weight, preferably between 5.0 and 25% by weight and

[0129] of additives are in general between 0 and 25% by weight, preferably between 0 and 20% by weight.

Anti-oxidants and inert fillers are taught [0121-0123]. Vegetable oils such as sunflower and olive oils, non-ionic surfactants and additives are taught [0112-0120].

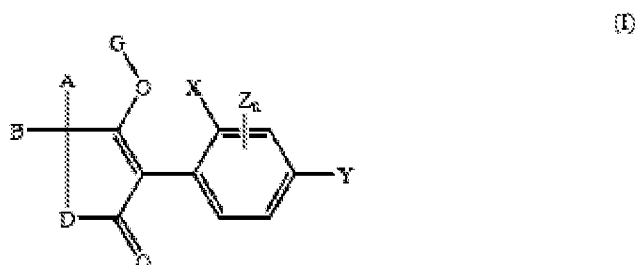
Turberg et al. teach compounds and methods for controlling parasites in the environment of animals in claims 1 and 2 (also in [0005-0030]) with compounds of the formula (in part from claim 1):



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NO CLAIM.

1. The use of phenylketoenol derivatives of the general formula (I)



in which

X represents alkyl, halogen, alkoxy or haloalkyl,

Y represents hydrogen, alkyl, halogen, alkoxy, haloalkyl,

Z represents alkyl, halogen alkoxy,

- A and B together with the carbon atom to which they are bonded form a saturated or unsaturated cycle which is optionally interrupted by hetero atoms and optionally substituted,

D represents oxygen, sulfur or —NH—,

In [0035-0040]:

.....

[0035] Compounds of the formula (I) which are preferably used are those

[0036] in which

[0037] X represents  $C_1$ - $C_6$ -alkyl, halogen,  $C_1$ - $C_6$ -alkoxy or  $C_1$ - $C_3$ -haloalkyl,

[0038] Y represents hydrogen,  $C_1$ - $C_6$ -alkyl, halogen,  $C_1$ - $C_6$ -alkoxy,  $C_1$ - $C_3$ -haloalkyl,

[0039] Z represents  $C_1$ - $C_6$ -alkyl, halogen,  $C_1$ - $C_6$ -alkoxy,

[0040] n represents a number from 0 to 3,

G represents H or —CO- $R^1$  and  $R^1$  is  $C_1$ - $C_{20}$  alkyl [0046 and 0050].

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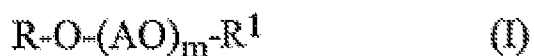
When A and B together form a ring, the ring can be saturated or unsaturated and substituted with alky and alkoxy groups for example [0043]. Alkoxy groups are taught broadly in [0013] and are further limited to C1-C6 alkoxy which would include methoxy in [0043]. Therefore, the instantly elected active is fairly taught by the reference.

Turberg et al. teach vegetable oils (page 8, column 2, [0180]; page 9, column 1, [0195]), surfactants including nonionic ones (page 9, column 1, [0200]), and optional additives including antioxidants and colorants (page 8, column 2, [0187]-[0190]) are included.

Turberg et al. teach an active agent presence of preferably 1.0- 40% by weight (see page 8, column 1, [0170]). Turberg et al. teach adjuvant components serving as extenders and/or surface-active reagents (see page 8, column 1, [0173]-[0175]).

Turberg et al. teach that the compounds are effective against tick species, fleas, lice and mites [0004]. Thus, the compounds can then be considered acaricides because ticks are in the subclass of acarina and fleas are in the class of insects so the compounds can also be considered insecticides.

Wolf et al., (although in German the chemical language remains understood in English), teach agrochemical active agents with alkanol alkoxylates of the formula:



which are closed penetrants in the vernacular of the instant invention. (page 7, line 25).

Wolf et al. teach that R is alkyl with 4-20 carbon atoms; m is a number from 1 to 30; R<sup>1</sup> is alkyl with 1-4 carbons and AO can be ethylene oxide or butylene oxide or mixtures

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(page 7 line 29-page 8, line 7). Thus Wolf et al. establish alkanol alkoxylates with terminal R groups.

Patel et al. teach the equivalence of using mineral oil or vegetable oil as a carrier in liquid suspension compositions (Abstract and claims 1 and 2).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

1. The difference between the instant application and Vermeer et al. is that Vermeer et al. do not expressly teach the instantly claimed active compound or a method of making, applying or controlling insects with the instant compound. This deficiency in Vermeer et al. is cured by the teachings of Turberg et al.

2. The difference between the instant application and Vermeer et al. is that Vermeer et al. do not expressly teach the instantly claimed closed penetrant or the specific species of closed penetrant in the composition or for use in the methods:



This deficiency in Vermeer et al. is cured by the teachings of Wolf et al.

3. The difference between the instant application and Vermeer et al. is that Vermeer et al. do not expressly teach adding mineral oil to the composition or to the methods. This deficiency in Vermeer et al. is cured by the teachings of Patel et al.

### **Finding of prima facie obviousness**

#### **Rational and Motivation (MPEP 2142-2143)**

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the compound of Turberg et al. in the composition and methods of Vermeer et al. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Vermeer et al. teach adding insecticides and Turberg et al. teach the instant compound as an insecticide. One of ordinary skill in the art would expect the compound of Turberg et al. to function as an insecticide in the composition and methods of Vermeer et al. Application of the composition comprising the insecticide of Turberg et al. intrinsically controls insects in their habitat.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the alcohol alkoxylate of Wolf et al. in the composition and methods of Vermeer et al. with the formula:



and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Vermeer et al. establish alcohol alkoxylates as penetration enhancers and teach using suitable penetration enhancers to improve penetration of the agrochemical active

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compounds [0068] and Wolf et al. teach other alcohol alkoxylates which one of ordinary skill in the art would understand to also function as penetration enhancers. In fact, similar properties may normally be presumed when compounds are very close in structure. *Dillon*, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. The comprising language of Vermeer et al. allows for the addition of other penetration enhancers. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Furthermore, it is deemed merely routine optimization of the number of ethylene oxide and isobutylene oxide groups in the general formula provided by Wolf et al. to derive the instant compounds in the absence of evidence to the contrary.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use mineral oil, as suggested by Patel et al., in the composition and methods of Vermeer et al. and produce the instant invention. One of ordinary skill in the art would expect to make a liquid suspension.

One of ordinary skill in the art would have been motivated to do this because Patel et al. render mineral oil and vegetable oil equivalent for use in liquid suspensions.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Ernst V Arnold/  
Primary Examiner, Art Unit 1616